



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,863	01/31/2001	Karl R. Olsen	9218/	2599

7590 07/06/2004

Brian J. Anderson - Morris, Manning & Martin, LLP
Morris, Manning & Martin, LLP
1600 Atlanta Financial Center
3343 Peachtree Road, NE
Atlanta, GA 30326-1044

EXAMINER

NGUYEN, NGA B

ART UNIT PAPER NUMBER

3628

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/774,863

Applicant(s)

OLSEN, KARL R.

Examiner

Nga B. Nguyen

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is the answer to the communication filed on January 31, 2000, which paper has been placed of record in the file.
2. Claims 1-19 are pending in this application.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 18-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 18-19 are claimed "a system" in the preamble but no means or structure has been recited.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 7, and 11-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang, U.S. Patent No. 5,848,400.

Regarding to claim 1, Chang discloses a method for electronic bill presentation and payment, comprising the entity steps of:

obtaining a plurality of bill files, each bill file associated with a particular billing and a particular billing account maintained at a biller's financial institution, each bill file including a plurality of records, each record identifying a particular invoice account and a corresponding balance representing a financial obligation owed by a corresponding customer to the billing entity (column 4, lines 15-18, lines 60-65). Note that in Chang's method, the payee may have an account with a regional bank or a correspondent bank, the payor may have an account with a regional bank or a correspondent bank, a regional bank can communicate with the other regional banks and correspondent banks (see figure 2, Regional Bank 202). Considering the case when the payee has an account with a regional bank called payee's regional bank, the payor has an account with another regional bank called payor's regional bank, payee's regional bank communicate electronic bills with payor's regional bank. Each regional bank has front end processor 220, bill processor 222, payment processor 228, settlement processor 224, accounting processor 232, bill mailboxes 226, routing table 231 (see figure 3), thus the functions of those processors are the same for both payee's regional bank and payor's regional bank.

processing records in each bill file by:

obtaining a routing address associated with a customer's financial institution where the corresponding customer maintains an account (column 4, line 60-column 5, lines 18; bill processor 222 determines the network identifier of payor's regional bank in order to sent the electronic bills);

Art Unit: 3628

obtaining customer account identification information identifying the corresponding customer's account at the customer's financial institution (column 4, lines 14-22; electronic check has associated payor, payor's financial institution, authentication data);

assembling a bill packet corresponding to the bill record, the bill packet including information from the corresponding bill record and the customer's account identification information (column 5, lines 18-22; bill processor 222 repackages the electronic bills based on each regional bank); and

transmitting the bill packet to an electronic repository corresponding to the customer's financial institution using the associate routing address (column 5, lines 4-22; bill processor 222 sends the electronic bills to the payor's regional bank using the routing table 231); and

processing the bill packets received by each electronic repository by:

sorting the received bill packets by customer's account information (column 5, lines 23-29; bill processor 222 receives electronic bills, determines which of the electronic bills are for clients having bill mailboxes at the bank);

assembling a bill presentation file containing information from the received bill packets for each customer account (column 5, lines 23-29; bill processor 222 posts the bills to the appropriate mailboxes); and

electronically presenting each bill presentation file for viewing and electronic bill payment (column 5, lines 43-48; the client may review and pay for the bills); .

Regarding to claim 2, Chang discloses obtaining a routing address comprises the steps of: obtaining a payment made by the customer remunerated to the billing entity; data mining the payment to obtain customer's financial institution data that distinctly identified the customer's financial institution (column 4, lines 14-22); associating the customer's financial institution data with a routing address (column 5, lines 13-22).

Regarding to claim 7, Chang discloses the step of assembling a bill packet further comprises the step of encrypting the bill packet (column 3, lines 32-37 and column 6, lines 13-16).

Regarding to claims 11, 13, Chang discloses the steps of electronically presenting each bill presentation file for viewing and electronic bill payment includes receiving authorization to debit a direct deposit account at the customer's financial institution and debiting the customer's direct deposit account (column 5, lines 43-60 and column 7, lines 17-23).

Regarding to claims 12, 14, Chang discloses the step of electronically presenting each bill presentation file for viewing and electronic bill payment includes authorization to charge a credit card of the customer and charging the customer's credit card (column 5, lines 43-60 and column 7, lines 50-67).

Regarding to claims 15, 17, Chang discloses recording the payment by the customer in a customer payment warehouse database and recording the payment to billing entity in a bill payment warehouse database (column 8, lines 14-43).

Regarding to claim 16, Chang discloses sending an automated payment to the biller's financial institution that originated the bill; crediting the billing account owned by

Art Unit: 3628

the biller at the biller's financial institution (column 8, lines 45-67); and notifying the billing entity that the bill base been paid (column 8, lines 10-13).

Claim 18 has the same limitations found in claim 1 above, therefore is rejected by the same rationale.

Regarding to claim 19, Chang discloses a system for electronic bill present and payment, comprises the steps of:

obtaining a payment made by a customer remunerated to a billing entity (column 4, lines 15-22; electronic check and credit transaction; column 4, lines 42-67; electronic bills);

data mining the payment to obtain customer's financial institution data that distinctly identifies a customer's financial institution (column 4, lines 15-22; electronic check and credit transaction contain payor's financial institution);

associating the customer's financial institution data with a routing address (column 5, lines 13-22; associating electronic bills with financial transaction server network identifier);

transmitting a bill packet to an electronic repository corresponding to the customer's financial institution using the associated routing address (column 5, lines 4-22; bill processor 222 sends the electronic bills to the payor's regional bank using the routing table 231.

Art Unit: 3628

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang, U.S. Patent No. 5,848,400.

Regarding to claims 3-4, Chang does not teach the customer's financial institution data include an American Bankers Association routing and transit number or an International Organization for Standardization issuer identification number. However, Chang teaches the customer's financial institution data include electronic check and credit transaction, each electronic check and credit transaction has authentication data required to authenticate the transaction (column 4, lines 15-22). Moreover, American a Bankers Association routing and transit number is well known authentication data contained in a check, an International Organization for Standardization issuer identification number is well known authentication data contained in credit transaction. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include a Bankers Association routing and transit number in Chang's electronic checks, include an International Organization for Standardization issuer identification number in credit transaction for the purpose of processing the electronic check and credit transaction.

Regarding to claims 5-6, Chang discloses obtaining a routing address comprises the steps of: associating the customer's financial institution with a globally unique identifier; receiving an Internet Protocol address corresponding to the globally unique identifier; loading information into a look-up table database that correlates the customer's financial institution with the Internet Protocol address (column 5, lines 13-22; mapping financial institution identifications into financial transaction server network identifiers, loading network identifiers into a routing table 231). Chang does not teach registering the globally unique identifier with an Internet Domain Name Service. However, Chang teach each customer's financial institution has a network identifier, moreover, in order to have a network identifier, it is well known in the art that each customer's financial institution must register with an Internet Domain Name Service. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Chang's for the purpose of obtaining a network identifier for each customer's financial institution in order to route the electronic bills to the customer's financial institution.

Regarding to claim 8, Chang does not disclose the step of processing the bill packets received by each electronic repository further comprises the step of decrypting the bill packet. However, Chang does teach all financial transaction messages are transmitted in encrypted form, thus the messages must be decrypted in order to be viewed by any entity such as the financial institution or the customer, moreover, decrypting messages using a proprietary decryption technique is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the

Art Unit: 3628

invention was made to include the feature above with Chang's for the purpose of providing the security to prevent the unauthorized user to gain access to the security information.

Regarding to claim 9, Chang does not disclose the step of assembling a bill packet further comprises the step of attaching to the bill record a Universal Resource Locator of a server operated by the billing entity to enable the customer to find detailed billing information. However, attaching to the bill record a Universal Resource Locator of a server operated by the billing entity is well known in the art. For example, an email message contained a hyperlink to the payee's website to enable the customer to review the billing details information and pay for the bills. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Chang's for the purpose of providing more conveniently and easily for the customer to review and pay for the bills because the customer does not have to find the Internet address of the payee's website sometimes the customer does not remember.

Regarding to claim 10, Chang does not disclose the step of electronically presenting each bill presentation file for viewing and electronic bill payment further comprises the steps of: providing securing for accessing the bill presentation file to ensure the privacy of any information displayed; providing security to ensure the confidentiality of any payment information received. However, providing securing for accessing the bill presentation file to ensure the privacy of any information displayed is well known in the art. For example, the user is usually required to provide ID and

password to gain access to the user's mailbox. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Chang's for the purpose of providing security to ensure the confidentiality of any payment information when the client reviews and pays for the bills via the client's mailbox.

Conclusion

9. Claims 1-19 are rejected.

10. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Kolling et al. (US 5,963,925) disclose the electronic statement presentment system replaces the preparation and mailing of paper statements and invoices from a biller with electronic delivery.

Bednar et al. (US 5,832,460) disclose the method and system for bill presentation and payment reconciliation.

Schutzer (US 6,292,789) discloses a method and system for presentment of bills on a computer network includes a biller account hosted on a server of a bill service provider for receiving a bill file from a biller that includes bill data.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (703) 306-2901. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

Art Unit: 3628

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (703) 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-1113.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/o Technology Center 3600

Washington, DC 20231

Or faxed to:

(703) 872-9326 (for formal communication intended for entry),

or

(703) 308-3691 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen



June 25, 2004